

REMARKS

The Examiner objected to the application under 35 USC §132(a), on the ground that Applicant's claim amendments constituted the impermissible addition of "new matter into the disclosure". As noted below, the Examiner has erroneously treated claim amendments as the addition of new matter into the disclosure. Moreover, when properly consider under 35 USC §112, ¶1, the claim amendments find support in Applicant's original disclosure as understood by the Examiner's previous Actions and the BPAI.

The Examiner rejected the amended claims under 35 USC §103(a) as obvious over U.S. Patent No. 4,704,091 to Owens *et al.* ("Owens"). The Examiner's §103(a) rejection is not based on the language of the independent claims, but on the Examiner's new conclusion that Applicant's disclosure does not support the single-material and single-step limitations of the previously amended claims. Thus, the Examiner's rejection is actually a rejection under 35 USC §112, ¶1. In supporting these rejections, the Examiner has raised an argument that is inconsistent with the Examiner's previous statements, the findings of the Board of Patent Appeals and Interferences ("BPAI") in the two appeals in this application, and the clear teaching of Applicant's disclosure. In light of the Examiner's erroneous and contradictory arguments, the rejections must be withdrawn.

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The Examiner objected to Applicant's March 20, 2007 amendment ("3/30/07 Amendment") under 35 USC §132(a). See April 20, 2007 Non-Final Action ("4/20/07 Action"), at 2-3. The Examiner asserted that Applicant's 3/30/07 Amendment "introduces new matter into the disclosure." See 4/20/07 Action, at 2 (emphasis added). The Examiner did not identify new matter added to the disclosure, in violation of 35 USC §132(a), but, instead, pointed to the Applicant's amendments to the claims as the source of the objection. In fact, the prosecution history reflects that Applicant has never made an amendment to the disclosure and Applicant has never introduced new matter into the disclosure. Applicant's amendments to the claims did not fall within the restriction imposed by §132(a) and the Examiner's objection must be withdrawn.

The statute relied on by the Examiner provides as follows:

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

See 35 USC §132(a) (emphasis added).

In connection with §132(a), Section 706.03(o) of the Manual of Patent Examining Procedure ("MPEP") explains (emphasis added): "35 U.S.C. 132 >(a)< should be employed as a basis for objection to **amendments to the abstract, specification, or drawings** attempting to add new disclosure to that originally disclosed on filing." See also MPEP 706.07(h), Subsection VII.

The Courts have ruled that §132(a) relates to "new matter" added to an application's disclosure, rather than claims. See *Westphal v. Fawzi*, 666 F.2d 575, 577 (CCPA 1981). In *Westphal*, the Court explained that later submitted claims are examined on the basis of adequacy of support in the original disclosure, and an amendment of a claim, or a later filed claim, does not constitute the addition of new matter within the meaning of §132. *Id.* Although introduction of new matter into the disclosure falls under the prohibition of 35 U.S.C. § 132, later submitted claims need only be reviewed for support in the original disclosure under § 112, first paragraph. *Id.*; see also *Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506, 1517 (Fed.Cir. 1984) ("sole question" is whether the claims entered by amendment were supported by the disclosure in the original application).

The facts here identical to those in *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981), where the Examiner's objection of a claim amendment as adding new matter in violation

of §132 was reversed. In that case, the examiner rejected the amended claim, saying the claim amendment broadened the scope of the original claims and constituted "new matter" prohibited by §132. *Id.*, 650 F.2d at 1213-14. The Examiner was affirmed by the Patent and Trademark Office Board of Appeals on the argument that allowance of the broader claim would be an enlargement of the scope of the "disclosure". *Id.* The Court of Appeals reversed the Board and explained that an objection that a claim amendment is not supported by the disclosure must be made under §112, ¶1:

The proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure, therefore, is § 112, first paragraph, not § 132. The latter section prohibits addition of new matter to the original disclosure. It is properly employed as a basis for objection to amendments to the abstract, specifications, or drawings attempting to add new disclosure to that originally presented.

*Id.*, 650 F.2d at 1214-15.

The first paragraph of Section 112 requires that claimed subject matter be supported in the specification. *Id.*, 650 F.2d at 1214. In the present case, the Examiner now argues that Applicant's Specification does not have support for the claim limitation of forming the "design surface" in the same manufacturing step as the formation of the "background surface" of the "raised portion" of the "housing". See 4/20/07 Action, at

2-3, and at 11-12. Although the "one-step" manufacturing process has been consistently accepted by the Examiner and the BPAI throughout the lengthy prosecution and appeals, the Examiner has raised this argument for the first time. In support of this new argument, the Examiner quotes three passages from the Specification. *Id.* The Examiner's new argument relies on taking partial quotations from Applicant's Specification, avoiding the surrounding disclosure, imposing an unreasonable interpretation of the partial quotation, and generally ignoring the teaching of Applicant's disclosure. The Examiner relies on this erroneous interpretation in support of the §132 objection (see 4/20/07 Action, at 2-3), as well as in support of the §103 rejection (*id.*, at 11-12). Therefore, the discussion below responds to both.

The basis of the Examiner's argument is that, contrary to all arguments made and considered previously by the Examiner, Applicant and BPAI, Applicant's disclosure requires two manufacturing steps to form a "design surface", such as a logo, in the "background surface" of the "raised portion" of the connector "housing": "to put any 'design' onto the raised portion takes another step and do [sic] not formed in the same step with the housing and the raised portion." *Id.*, at 3 and 12 (emphasis added in bold, underlining in original). The Examiner misinterprets the teaching of Applicant's disclosure and argues

that it teaches only placing designs "onto" the raised portion, thereby teaching a two-step manufacturing process identical to the Owens reference. The Examiner's argument fails because it contradicts the Examiner's previous understanding of the disclosure<sup>1</sup>, as well as the BPAI's understanding of the disclosure. These understandings were consistent with Applicant's teaching; namely, the invention's disclosure teaches forming the "design surface" as part of the "raised portion" in a single manufacturing step, thereby overcoming the problems of the multiple steps required by the prior art.

During the first appeal in the prosecution of the Parent application, the BPAI made the following determination:

Appellant argues that the invention requires that the surface comprises a design formed as part of the surface and that the design is incorporated into the surface of the raised

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<sup>1</sup> See, e.g., December 8, 2000 Non-Final Action (12/8/00 Action"), in the parent application, No. 09/657,869 ("Parent"), at 4 ("logos can be formed in the molding process"); February 27, 2002 Examiner's Answer ("2/27/02 Answer") in first appeal, No. 2002-1175, at 5-6 ("the Huang invention was conceived to overcome [sic] necessity of an additional molding step **by incorporating a design into** the raised portion of the connector housing **when the housing is manufactured**"; emphasis added by underlined italics, but bolded text is from original); January 6, 2004 Non Final Action in the instant application ("1/6/04 Action"), at 3 (Owens does not teach a design surface formed as part of the background surface); July 14, 2005 Non-Final Action ("7/14/05 Action"), at 11-12 (arguing that Applicant's single-step manufacturing process is an unpatentable "product by process"); and February 28, 2006 Examiner's Answer ("2/28/06 Answer") in the second appeal, No. 2006-2187, at 5 citing Owens as a \$103 reference, rather than a \$102 reference, because it does not teach forming the design surface as part of the background surface).

portion of the connector when the housing is manufactured thereby removing an additional molding step which would be required by Owens. [Citation to the brief omitted.] While we agree with appellant concerning the simplification of the manufacturing process, we find no limitation in the language of independent claim 1 to distinguish it from the connector/article of manufacture of Owens.

See June 17, 2003 Decision on Appeal of the BPAI in *Ex Parte George Y. Huang*, Appeal No. 2002-1175 ("6/17/03 Decision"), at 4-5 (emphasis added).

The BPAI's understanding that Appellant's disclosed invention simplifies the manufacturing process finds support in the Specification. The Specification's "Discussion of the Prior Art" identifies the problem of applying a "surface design" to a connector by means of a "two-step molding process". See Specification, at 2:19-23. To overcome this problem with the prior art, the invention proposed a single-step process to incorporate a design into the raised portion of the connector housing, thereby allowing the housing and the design to be molded as part of the same process:

The present invention provides a connector or adapter housing structure that provides a raised portion that will be exposed after the outer plastic covering is molded onto the connector or adapter. This raised portion of the housing exposes an area where logos or other information can be placed on or molded into the raised portion. This eliminates the need to apply a logo through a second injection molding process or

**by affixing it in a later manufacturing step.** The raised portion also provides a more discernable and durable surface for logos than the molded plastic covering. Moreover, with transparent plastic coverings of recent designs, the raised portion of the present invention provides the best surface for logos or other information. In this way, a cable connector or adapter can be manufactured and assembled with fewer parts and steps, and the finished product will provide a superior surface for logos and information.

See Specification, at 3:17-4:4 (emphasis in bold and italics added). In support of the \$132(a) objection and \$103(a) rejection, the Examiner quoted only the second sentence from this passage (see 4/20/07 Action, at 2 and 11), and interpreted the sentence in isolation as meaning that a second manufacturing step is required to put a design "onto" the raised portion of the housing (*id.*, at 3 and 12). To reach this erroneous interpretation, the Examiner has to ignore the following sentence, which explains that, by molding the design into the raised portion of the housing, a second manufacturing step is avoided.

In the "Description of the Invention", Applicant's disclosure teaches that the specifically disclosed embodiment shows a "single-piece, molded metal housing 14" (see Specification, at 5:10-11), with a "raised portion 17" that may be "formed as part of the molded metal housing 14":

A raised portion 17 of the housing 14 extends above the outer surface of the



housing 14. In the embodiment shown in Fig. 2, the raised portion 17 is formed as part of the molded metal housing 14. It is also contemplated that the raised portion 17 could be applied to the housing 14 in other ways. For example, the raised portion 17 could be glued or soldered to the housing 14, or the raised portion 17 of the housing 14 could be formed as part of a stamping process. In any event, persons skilled in the art will recognize that a raised portion 17 may be incorporated into or formed onto a housing 14.

*Id.*, at 5:18-27 (emphasis added). Of significance in the passage quoted above is the description of the other possible ways by which the raised portion (17) could be "applied" to the housing (14), such as by gluing or soldering. These alternative embodiments distinguish between molding the raised surface (17) in one manufacturing step along with the housing (14) from "applying" the raised portion to the housing in a separate manufacturing step. In the present status of the claims being examined, the claim language is directed to the narrower teaching of a design surface, a raised portion and a housing formed of the same material (claim 1) and as part of a "first manufacturing step" (claim 17). As such, the Specification discloses this embodiment.

The Specification goes on to explain that the raised surface (17) provides a surface into which designs, such as logos, may be molded during manufacturing, providing a "clearly visible" place

for the logo and thereby another problem of the prior art (designs molded into the housing cannot be seen clearly through transparent plastic coverings):

The raised surface 17 provides a place where logos or information may be placed. For example, Fig. 3 shows a completed cable connector with a logo 18 **molded into the raised portion 17**. Thus, after manufacturing and assembly, the cable connector will have a clearly visible area on the raised portion 17, not covered by the injection molded plastic covering 11, where a logo or information may be seen.

*Id.*, at 6:10-18 (emphasis added in bold and italics). In support of the §132(a) objection and §103(a) rejection, the Examiner quoted the first and second sentences of this passage (see 4/20/07 Action, at 3 and 11), and interpreted the second sentence as meaning that a second manufacturing step is required so that the logo can be molded into the raised portion of the housing (*id.*, at 3 and 12). To reach this erroneous interpretation, the Examiner has to ignore the Specifications related teachings, which explain that, by molding the design into the raised portion of the housing, a second manufacturing step is avoided. Moreover, the Examiner's new argument and the erroneous interpretation of the Specification contradict the Examiner's previous admissions that the disclosure teaches a single-step process of manufacturing a design into the raised portion during molding of the housing. See footnote 1, *supra*, e.g., 2/27/02

Answer in first appeal, No. 2002-1175, at 5-6 ("the Huang invention was conceived to overcome [sic] necessity of an additional molding step **by incorporating a design into the raised portion of the connector housing when the housing is manufactured**"; emphasis added by underlined italics, but bolded text is from original). In light of the Examiner's earlier understanding of the disclosed invention, the new argument is unfounded and contradictory. Moreover, the Examiner's erroneous interpretation directly contradicts the BPAI's understanding of the disclosure as teaching a single-step manufacturing process to overcome the disadvantages of the multi-step processes of the prior art. See 6/17/03 Decision, at 4-5.

The highlighted portion of the quotation from the Specification above identifies that Applicant's disclosure expressly teaches forming the "design surface" ("logo" in the preferred embodiment) as part of the raised portion (17) of the housing (14) in a single molding step. This teaching is repeated and further explained in connection with the Specification's description of an adapter according to the invention:

A raised portion 17 of the housing 14 extends above the outer surface of the housing 14. In the embodiment shown in Fig. 4, **the raised portion 17 is formed as part of the molded metal housing 14.** It is also contemplated that the raised portion 17 could be applied to the housing 14 in other ways, as mentioned above. Once the connectors 12 and 26, housing 14, and conductors 23 are

assembled, plastic is usually injection molded over the assembly to form an outer plastic covering 11. According to the present invention, the raised portion 17 will not be covered by the injection molded plastic covering 11, but will be exposed. The raised portion 17 may be higher or a little lower than the outer covering 11, as described above. As with the cable connector 10 described above, **the raised portion 17 of the adapter 27, shown in Fig. 4, may be used as a surface for molded logos or designs 18, labels (not shown), or a gripping surface (not shown).**

*Id.*, at 7:22-8:9 (emphasis in bold and italics added). In support of the §132(a) objection and §103(a) rejection, the Examiner quoted only the last sentence from this passage (see 4/20/07 Action, at 3 and 11), and interpreted the sentence in isolation as meaning that a second manufacturing step is required for molding logos or designs "onto" the raised portion of the housing (*id.*, at 3 and 12). To reach this erroneous interpretation, the Examiner has to ignore the preceding teachings, which explain that, by molding the design into the raised portion of the housing, a second manufacturing step is avoided.

The Examiner's §132(a) objection was improper, insofar as it was applied to Applicant's amendments to the claims, rather than to the disclosure. No new matter has ever been introduced into the disclosure since the original Parent application was filed. To the extent the Examiner is attempting to argue that

Applicant's disclosure fails to provide a written description, under §112, ¶1, of a single-step manufacturing process to create an electrical connector with a design surface formed as part of a raised portion during the molding of the housing, the above-quoted portions of the Specification provide clear support for this teaching, to which the claims at issue are directed. To the extent the Examiner is attempting to argue that Applicant's amended claims are different from the previously presented claims, the narrowing claim amendments are allowed. See *Aerosol Research Co. v. Scovill Mfg. Co.*, 334 F.2d 751, 141 USPQ 758 (7<sup>th</sup> Cir. 1964).

For the reasons set forth above, the Examiner's objection under 35 USC §132(a) was improper and must be withdrawn.

***Claim Rejections - 35 USC § 103***

**1. §103(a) Rejection of Independent Claims 1, 12 and 17**

The Examiner's §103(a) rejection is not based on the language of the claims being examined, but on the Examiner's interpretation of Applicant's disclosure. Thus, after quoting from "fragments" of Applicant's Specification, the Examiner argues that it fails to teach a single-step manufacturing process: "All those fragments show that to put any indicia/design surface onto the raised portion takes another step and do [sic] not formed in the same step with the housing and raised portion." See 4/20/07 Action, at 12. The rejection is not based on

§103(a), because it is not based on the language of the claims presented for examination in view of the prior art Owens reference.<sup>2</sup> Rather, the rejection is based on an implied failure, under 35 USC §112, ¶1, to provide a written description to support the single-material and single-step limitation of the amended claims. This argument does not address the claims, but the disclosure, and is, therefore, incorrectly presented as an obviousness rejection under §103.

In response to the Examiner's new argument that Applicant's disclosure does not support the single-material and single-step limitations, as noted above in connection with the §132(a) objection, this argument was never raised before, contradicts the Examiner's previous arguments during prosecution of this application and its related appeals, and contradicts the findings of the BPAI. Accordingly, the Examiner's argument underlying the §103(a) rejection is based on an unsupported and inconsistent interpretation of Applicant's disclosure.

The Examiner now argues that the Applicant's disclosure does not disclose a design surface and raised portion that can be manufactured in a single manufacturing step along with the housing. The Examiner's new argument is that the underlying

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<sup>2</sup> In fact, the Examiner has admitted throughout prosecution that Owens does not teach "a design surface ... formed as part of the background surface". See, e.g., 7/14/05 Action, at 4.

disclosure teaches two, separate manufacturing steps in order to mold a design "onto" the raised portion of the housing. See 4/20/07 Action, at 12. Based on this erroneous interpretation of Applicant's disclosure, the Examiner rejects the claims as obvious over the Owens reference, which admittedly teaches a multi-step manufacturing process. The Examiner's interpretation of Applicant's disclosure is directly contrary to its express teaching and contradicts the BPAI's previous findings.

The argument set forth in detail above in connection with the Examiner's §132(a) objection to the Specification applies to the identical argument made in support of the §103(a) rejection. Cf., 4/20/07 Action, at 2-3 (in connection with the §132(a) objection), and at 11-12 (in connection with the §103(a) rejection; the same argument is copied from one section to the other). For the reasons set forth above, the Examiner's new interpretation of Applicant's disclosure cannot stand and must be withdrawn. In light of the Examiner's erroneous new interpretation, the §103(a) rejection lacks support and must, too, be withdrawn.

Additionally, the Examiner has failed to take into consideration the findings and arguments of the BPAI in the second appeal. As noted in Applicant's Preliminary Amendments to the claims in support of its Request for Continued Examination, the BPAI found that the claims before it lacked "temporal" or

"material" limitations to distinguish the disclosed single-step manufacturing process of the disclosed invention from the multi-step process required by the teaching of the Owens reference. See Applicant's March 30, 2007 Response to July 14, 2005 Action ("3/30/07 Response"), at 9-10. Applicant, therefore, amended the claims of the application, and added a process claim, to present claims consistent with the BPAI's finding.

Applicant appealed the 7/14/05 Action to the Board of Patent Appeals and Interferences ("BPAI"). On January 31, 2007, the BPAI issued its Decision on Appeal ("1/31/07 Decision"). In its 1/31/07 Decision, the BPAI rejected Applicant's argument that the claims overcame the "later manufacturing step" problem of the prior art, because the claims did not include language of such a "later manufacturing step" limitation nor of how many steps were required to form the claimed surfaces. *Id.*, at 7. The BPAI concluded that independent claims 1 and 12 included neither limitations relating to the time period during which surfaces are formed nor distinctions between the materials of which the surfaces are formed:

We find no temporal limitation as to the time of being "formed" or limitation that the surfaces are made of the same material so as to distinguish over the Examiner's reasonable claim interpretation and application of the prior art of Owens.

*Id.*, at 9. The BPAI affirmed the rejections of most of the



remaining dependent claims, noting that a "single step process" was not supported by the claim language. *Id.*, at 9-10 (with respect to claims 3 and 14; "we do not find the argument to the single step process to be well supported in the claim language"), at 10 (with respect to claims 1, 3-10, and 15; "we do not find the argument to the single step process or elimination of multi-step processes to be well supported in the claim language"), at 10 (with respect to claims 4, 7, 8, and 15; "the molding of Biche would have suggested that a separate step of molding could be used with Owens"), and at 10-11 (with respect to claims 5, 6, 9, 10, and 11; "Appellant presents the same argument as above that the references do not disclose the claimed structure or process of manufacturing").

Applicant amended independent claims 1 and 12 in light of the BPAI's decision. Thus, the claims have been amended to include the limitation that the "material" from which the housing is formed is the same material from which the design surface is formed. Further, the claim has been amended to add the "temporal" limitation that the raised portion, background surface, and design surface are "formed along with the housing". In this way, the claims reflect the limitation that the design surface is formed of the same material as the housing, thereby distinguishing the invention from Owens, which teaches the use of a separate "informative plaque". See Owens, at Abstract ("a

final yoke assembly is molded encompassing the ... informational plaque"); see also Col. 1:47-48 ("information plaques molded into the yoke"), Col. 1:59-60 ("a molded contact pin dot information plaque in the yoke"), Col. 3:50-58 ("[i]n forming outer yoke 14, a high grade polymer molding compound flows around and is molded to the inner yoke 12, around color coded alpha-numeric labeling inserts 28a-28n leaving the upper surface of the inserts 28a-28n exposed, around the raised planar informative plaque member 26, and around bottom elongated oval member 36 as illustrated in FIG. 3 also leaving their exterior surfaces exposed"), Col. 4:48-49 (dependent claim 4, "System of claim 1 including information plaque means molded into said outer yoke housing"), and Col. 4:60-62 (independent claim 4, "c. molding an outer yoke housing incorporating an information plaque and the inner yoke body of step (b)"). Owens' teaching reflects the problem of the prior art disclosed by Huang:

To provide a place for a manufacturer's name or for part identification, the plastic covering 11 of conventional connectors is sometimes molded with a recess 20. In the recess 20, identifying logos, designs, words, or numbers are often formed in the molding process, leaving raised or indented surfaces (not shown) in the plastic covering 11. Or, a label (not shown) can be affixed in the recess 20 after molding. Some designs have a raised surface design by placing the cable connector 10 or adapter in a second injection mold and adding a second plastic surface 15. This two-step molding process allows different colors or textures of plastic to be

used.

See Huang, ¶ 0007 (emphasis added). In summary, Owens teaches and Huang discloses as prior art a multi-step and multi-material molding process to incorporate an "informational plaque" (Owens) or "raised surface design" (Huang's disclosure of prior art) into a final plastic connector. The amendments to claims 1 and 12 overcame the Owens reference, in light of the Decision of the BPAI, by clarifying the limitation that the claimed design surface is formed along with and of the same material as the housing.

Applicant also added a new independent claim 17 directed to the single step method of manufacturing taught by Applicant's invention. This claim recites a "first manufacturing step", which includes the formation, from a single material, of the housing, raised portion, and background and design surfaces, and a "second manufacturing step" of forming a cover, from a "second material", over the housing and around the raised portion. The new claim addresses the manufacturing method to which the Applicant's invention may be directed.

As noted above, the BPAI rejected dependent claims 3-10 and 14-15 based upon the lack of limitation as to "time of being 'formed' or limitation that the surfaces are made of the same material". See 1/31/07 Decision, at 9. The amendments to independent claims 1 and 12, as well as the new independent claim

17, address these issues.

The Examiner's §103(a) rejection is not based on the language of the claims being examined, but on the Examiner's interpretation of Applicant's disclosure. Thus, after quoting from "fragments" of Applicant's Specification, the Examiner argued that it failed to teach a single-step manufacturing process: "All those fragments show that to put any indicia/design surface onto the raised portion takes another step and do [sic] not formed in the same step with the housing and raised portion." See 4/20/07 Action, at 12. The rejection is not based on §103(a), because it is not based on the language of the claims presented for examination. Rather, the rejection is based on an implied failure, under 35 USC §112, ¶1, to provide a written description to support the claims.

Because the Examiner has previously admitted that the Owens reference does not teach "a design surface ... formed as part of the background surface" (see 7/14/05 Action, at 4), and because the previously amended claims clarify that the "design surface" formed in the "background surface" of the "raised portion" is formed from the same material (claims 1 and 12), and during the single "first manufacturing step" (claim 17), as the "housing", the claims are not rendered obvious by Owens.

2. Rejection Under In Re Seid

The Examiner has repeated the obviousness rejection on the

unsupported contention that the claimed "raised portion" structure is mere ornamentation, and, therefore, Owens anticipates it, even though the Examiner admits that Owens lacks the claimed structure. See 4/20/07 Action, at 12; see also 7/14/05 Action, at 10-11. The Examiner did not include this argument in the 2/28/06 Answer in the second appeal and it is, therefore, waived.

Even if this abandoned ground for rejection is considered, it fails, as the Examiner has not correctly applied the underlying authority. The Examiner incorrectly cites *In re Seid*, 161 F.2d 229 (C.C.P.A. 1947), for the proposition that the "design surface" claimed by Applicant constitutes mere "ornamentation" and is, therefore, not a proper subject matter for a utility patent claim. The Examiner misinterpreted the ruling in *In re Seid*. In that case, the claim at issue involved a soda bottle with "an artificial display figure... representing exteriorly a human head and upper body trunk", of a specifically claimed form, to fit over the bottle's neck. *Id.*, 161 F.2d at 229-30. The claim was rejected as obvious in light of several prior art patents disclosing bottles with neck coverings and human figures. *Id.*, 161 F.2d at 230. The Court held that the "particular shape and arrangement" of the applicant's claimed human figure, "including the arrangement of the arms", related "to ornamentation only and have no mechanical function

whatsoever." *Id.*, 161 F.2d at 231. It should be noted that all of the issued prior art patents discussed in *In re Seid* included claims for structures intended to provide a place for a design - ornamentation - on bottles. The applicant's difficulty in *In re Seid* was that the claimed bottle design was only distinguishable to the extent it recited a *specific design* of a human form. Thus, *In re Seid* stands for the rule that a claim reciting a specific ornamental design, such as a human figure arranged in a particular way, cannot be distinguished from prior art that discloses a generic design, such as a human figure.

In this application, the Examiner argues that, since the claims relate to a structure with background surface and a design surface, they claim "matters relating to **ornamentation only which have no mechanical function**" and are unpatentable. See 4/20/07 OA, at 12 (emphasis in original). The Examiner has confused mechanical structure having the function of providing a place for ornamentation with the ornamentation itself. In the present application, Applicant has made no claim to a particular ornamentation; rather, Applicant has claimed a mechanical structure, with expressly detailed industrial advantages, that can provide a "design surface" of a certain type. Thus, *In re Seid* does not support the Examiner's rejection. Moreover, all the prior art cited in *In re Seid* involved issued patents that claimed structures for locating ornamental designs, which is the

case in the present application.

Finally, the mechanical advantages of the present design have been expressly recited in Applicant's Specification. See Specification, at pp. 1:23-4:4. The problem of a two-step molding process to apply manufacturers' designs is expressly described. *Id.*, at p. 2:13-23. The problem of distinguishing a manufacturer's design through transparent plastic is also described. *Id.*, at p. 2:253:10. The present invention provides a mechanical structure for an electrical connector that overcomes these problems. *Id.*, at p. 3:15-4:4. The specific form of an ornamental design is not claimed. Therefore, the Examiner's reliance on *In re Seid* is misplaced.

### 3. Dependent Claims

the BPAI rejected dependent claims 3-10 and 14-15 based upon the lack of limitation as to "time of being 'formed' or limitation that the surfaces are made of the same material". See 1/31/07 Decision, at 9. The amendments to independent claims 1 and 12, as well as the new independent claim 17, address these issues.

In light of these amendments, the Applicant respectfully submits that independent claims 1, 12 and 17, along with dependent claims 3-10 and 14-15, are in a condition for allowance.

The BPAI affirmed the Examiner's rejection of dependent

claims 11 and 16, which claim a "gripping surface", citing lack of claimed structure. See 1/31/07 Decision, at 11. These claims have been amended to clarify that the claimed "gripping surface" is formed of the same material and at the same time as the housing, raised portion and background and design surfaces. Also, these claims were amended to add the limitation that the gripping surface comprised "ridges", thereby identifying structure. In light of these amendments, the Applicant respectfully submits that dependent claims 11 and 16 are in a condition for allowance.

The Examiner argues that Owens, in view of U.S. Patent No. 4,704,091 to Williams ("Williams"), renders claims 3 and 14 (sub-surface limitation) obvious. See 4/20/07 Action, at 5. The Examiner admits that Owens does not disclose a design surface that is below the background surface, but argues that Williams' "tire applique" (see Williams, Abstract) teaches such a structure, and it would have been obvious to combine the references "in order to provide some identification information". *Id.* The Examiner goes on to explain that "how the design surface [is] arrange [sic], above or below the background surface, depend only from the method of forming the design surface by adding or subtracting material." *Id.* Again, the Examiner fails to appreciate that the multi-step manufacturing process necessary to create the laminate structure described in Williams:



In a preferred embodiment, the present invention comprises a tire applique having a **first elastomeric layer**, a **second stamping layer** secured to the first layer, and a **data material layer** stamped to the second layer. A **backing material** mounted to the first layer is removed and the applique is secured to a tire by a suitable adhesive. Other aspects of the present invention relate to the combination of the applique and a tire, and to the process for marking a tire by applying the applique to the tire.

See Williams, at Col. 1:61-2:2 (emphasis added). Williams discloses an appliqué with four layers and a process of applying the appliqué in a separate step. As discussed above, in reference to the Examiner's obviousness rejection of claims 1 and 12 in view of Owens, the Examiner fails to understand the problem of the prior art (i.e., multi-step process), and the object of Applicant's invention in solving this problem by disclosing a structure that has a design surface formed as part of the connector housing and, therefore, capable of being manufactured in a single step.

The Examiner argues that Owens and Williams, as applied above to dependent claim 3, and further in view of U.S. Patent No. 4,202,351 to Biche ("Biche"), render claim 4 obvious. See 4/20/07 Action, at 5-6. The Examiner argues that Owens, modified by Williams, "include most of the invention, except for a design surface formed during molding of the housing." *Id.*, at 6. However, as argued above, neither Owens nor Williams disclose the

structure claimed by the Applicant. The molding structure of Biche involves "an identification cap 42" on a medical instrument. See Biche, at Col. 6:26 and Abstract ("identification means is disclosed for use with lead wires in electrocardiographic monitoring instruments"). The use of a molding a plastic "identification cap", taught by Biche, does not relate to the "housing" with a "raised portion" forming a "design surface" on which a design, such as a logo, can be molded in a sub-surface or above-surface design, as claimed here. Neither Owens nor Williams nor Biche suggest molding a design as part of a raised portion of a housing. The Examiner's argument that molding is a well-known method of manufacture fails to overcome the step of applying this method to the single electrical connector structure disclosed and claimed by Applicant. As explained above, the rejected claims are distinguishable over the prior art, because they claim structures that overcome the problems of the prior art; namely, providing a design surface in which and onto which "logos or other information can be placed on or molded into", to overcome the multi-step molding and transparent plastic covering problems. See Specification, "Summary of the Invention", at p. 3:15-4:4. The Specification also explains that the claimed structure can provide a cable connector that "can be manufactured and assembled with fewer parts and steps", and a finished product with "a superior surface

for logos and information." *Id.* Thus, the claimed structure and process for manufacturing that structure have expressly described advantages over the prior art.

The Examiner argues that Owens and Williams, as applied to dependant claim 3 above, further in view of U.S. Patent No. 4,275,768 to Riggs ("Riggs"), renders claim 5 obvious. See 4/20/07 Action, at 6. The Examiner argues that Owens and Williams are the primary references. However, as argued above, neither Owens nor Williams disclose the structure claimed by the Applicant. Riggs describes "engraving". As with Biche, the claimed single-material structure and single-step manufacturing process for manufacturing that structure have expressly described advantages over the prior art. Neither Owens nor Williams nor Riggs teach or suggest this structure or process.

The Examiner argues that Owens and Williams, as applied to dependant claim 3 above, further in view of U.S. Patent No. 4,960,391 to Beihaeur et al. ("Beihaeur"), render dependant claims 6 obvious. See 4/20/07 Action, at 7. The Examiner argues that Owens and Williams are the primary references. However, as argued above, neither Owens nor Williams disclose the single-material structure nor the single-step manufacturing process claimed by the Applicant. As with Biche, the claimed structure and process for manufacturing that structure have expressly described advantages over the prior art. Neither Owens nor

Beihaur teach or suggest this structure or process.

The Examiner argues that Owens in view of Biche renders claims 7, 8 and 15 obvious. See 4/20/07 Action, at 7-8. The Examiner argues that Owens "discloses most of the invention ... except for a design surface is a surface formed in the background surface (top surface of 26) above the background surface." *Id.*, at 7. The Examiner argues that Biche fills the gap by teaching a "cap" placed on top of the connector. However, as noted above, Owens does not teach the single-material structure or single-step manufacturing process claimed by the Applicant to overcome the problems of the prior art, such as the prior art shown in Owens and Biche. The molding structure of Biche involves "an identification cap 42" on a medical instrument. See Biche, at Col. 6:26 and Abstract ("identification means is disclosed for use with lead wires in electrocardiographic monitoring instruments"). The use of a molding a plastic "identification cap", taught by Biche, does not relate to the "housing" with a "raised portion" forming a "design surface" on which a design, such as a logo, can be molded in a sub-surface or above-surface design, as claimed here. Neither Owens nor Biche suggest molding a design as part of a raised portion of a housing, the very problem the present invention is intended to overcome. The Examiner's argument that molding is a well-known method of manufacture fails to overcome the step of applying this method to

the single electrical connector structure disclosed and claimed by Applicant. As explained above, the rejected claims are distinguishable over the prior art, because they claim structures that overcome the problems of the prior art; namely, providing a design surface in which and onto which "logos or other information can be placed on or molded into", to overcome the multi-step molding and transparent plastic covering problems. See Specification, "Summary of the Invention", at p. 3:15-4:4. The Specification also explains that the claimed structure can provide a cable connector that "can be manufactured and assembled with fewer parts and steps", and a finished product with "a superior surface for logos and information." *Id.* Thus, the claimed structure and process for manufacturing that structure have expressly described advantages over the prior art.

The Examiner argues that Owens, in view of Biche, as applied to dependant claim 7 discussed above, and further in view of Riggs renders claim 9 obvious. See 4/20/07 Action, at 8-9. The Examiner argues that Owens and Biche are the primary references. However, as argued above, neither Owens nor Williams disclose the single-material structure nor the single step manufacturing process disclosed and claimed by the Applicant. Riggs describes "engraving". As with Biche, the claimed single-material structure and single-step manufacturing process for manufacturing that structure have expressly described advantages over the prior

art. Neither Owens nor Biche nor Riggs teach or suggest this structure or process. These references merely describe the prior art which reflect the problem the claimed invention is intended to overcome.

The Examiner argues that Owens and Biche, as applied to dependant claim 7 discussed above, further in view of Beihaur render dependant claims 10 obvious. See 4/20/07 Action, at 9. The Examiner argues that Owens and Biche are the primary references. However, as argued above, neither Owens nor Biche disclose the single-material structure nor the single-step manufacturing process claimed by the Applicant. The claimed structure and process for manufacturing that structure have expressly described advantages over the prior art. Neither Owens nor Biche nor Beihaur teach or suggest this structure or process. In fact, these references merely describe the prior art which reflect the problem the claimed invention is intended to overcome.

The Examiner argues that Owens, in view of Wiebe, renders claims 11 and 9 (gripping surface), obvious. See 4/20/07 Action, at 9-10. The Examiner argues that Owens is the primary reference. However, as argued above, Owens does not disclose the single-material structure nor the single-step manufacturing process claimed by Applicant. The claimed structure and process for manufacturing that structure have expressly described

advantages over the prior art. Neither Owens nor Wiebe teach or suggest this structure or process. The Examiner cited no suggestion or motivation to combine Owens with Wiebe. Rather, the Examiner improperly cited the desirability of providing a gripping surface (see 4/20/07 Action, at 10: "to permit one to better grip the connector") as the motivation to combine the references. This type of circular argument cannot form the basis of an obviousness rejection. Moreover, these references merely describe the prior art which reflect the problem the claimed invention is intended to overcome.

#### CONCLUSION

The Examiner's §132(a) objection was improperly based on Applicant's amendments to the claims, rather than the disclosure. The Examiner's reliance on that statute was erroneous and must be withdrawn. To the extent the Examiner's §132(a) objection was, in fact, a rejection under §112, ¶1, it fails because the Examiner's prior arguments, as well as the BPAI's findings, contradict the Examiner's new interpretation of Applicant's disclosure.

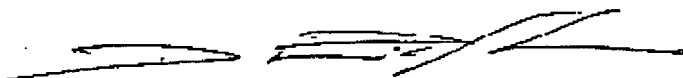
The Examiner's §103(a) rejection was improperly based on the Examiner's interpretation of Applicant's disclosure, rather than the language of the claims. As such, the rejection was not one under §103(a), but under §112, ¶1. The rejection fails, because the Examiner's prior arguments, as well as the BPAI's findings,

contradict the Examiner's new interpretation of Applicant's disclosure.

The Examiner's rejection of the dependant claims are based on the improper and incorrect arguments related to Applicant's disclosure and the Examiner's new interpretation of that disclosure. As such, the rejections of the dependent claims are not supported and must be withdrawn.

Owing to the Examiner's errors in the 4/20/07 Action, the objections and rejections must be withdrawn. Applicant respectfully submits that the claims are, therefore, in a condition for allowance.

Respectfully submitted,



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